

Attorney Docket No. P68-US

REMARKS

Claims 1-133 are pending, and no claims stand allowed. Of the pending claims, claims 1, 41, 122, and 133 are in independent form. Claim 133 has been canceled without prejudice in favor of the prosecution of the remaining pending claims.

An interview between the examiner and the applicants' representative Greg Muir was conducted on October 25, 2004, and is appreciated by the applicants and the representative. The substance of the interview is incorporated in the following remarks.

Objection to the drawings

In response to the examiner's objection to the drawings, the numerals in drawing pages 1/9 and 4/9 have been corrected. Replacements drawings are submitted herewith.

Rejection of claims under §112, 2nd paragraph.

In response to examiner's rejection of claims 15-17, 20, 55-57, and 60, amendments have been to correct the insufficient antecedent basis problem in these claims.

§102(a) Rejection based on the admitted prior art

The examiner interpreted dependent claim 84 from claim 41 as the Jepson-type claim, and rejected independent claims 1 and 41 under §102(a) over the clause before "*the improvement in which*" of claim 84. This rejection is respectfully traversed.

First, at all events, the subject matter set forth in the clause before "*the improvement in which*" of claim 84 is not any of the §102(a) events (known, used by others in this country, patented, or described in a printed publication before the invention thereof), upon which a §102(a) rejection of independent claims 1 and 41 can be properly made. Specifically, the subject matter of claims 1 and 41, and claim 84 have the same invention date, and are consequently presented in the same application.

Second, the undersigned has not been able to find any case or rule that mentions a Jepson dependent claim. It is believed that the Jepson claim format concept only applies to independent claims and is not appropriate or logical for application to dependent claims. 37 C.F.R. 1.75(e) encourages the use of improvement or Jepson-style claims. "(e) *Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) a phrase*

Attorney Docket No. P68-US

such as 'wherein the improvement comprises,' and (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion." 67 (emphasis added). As can be seen in 37 C.F.R. 1.75(e), reference is made to any "independent claim"

Third, as set forth in *Sjolund v. Musland*, the Jepson format is only an implied admission. *Sjolund v. Musland*, 847 F.2d 1573, 1577, 6 USPQ2d 2020, 2023 (Fed. Cir. 1988) ("[T]he preamble of a Jepson claim is impliedly admitted to be prior art."); *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979) ("We agree that the preamble elements in a Jepson type claim are impliedly admitted to be old in the art, ... but it is only an implied admission. The fact that none of the art cited by the examiner shows the combination recited in the claim preambles gives credence to appellants' explanation for drafting the claims in Jepson format, which was not intended as an admission, but was to avoid a double patenting rejection in a co-pending case unavailable to the public.") Based upon the "implied admission" nature, the undersigned believes that the Jepson issue can be removed simply by rewriting the claim into a non-Jepson claim form.

Fourth, as stated (with emphasize) in MPEP 2129 Admissions as Prior Art [R-2]:

"When applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. In re Nomiya, 509 F.2d 566, 184 USPQ 607, 610 (CCPA 1975) (Figures in the application labeled "prior art" held to be an admission that what was pictured was prior art relative to applicant's invention.).

A JEPSON CLAIM RESULTS IN AN IMPLIED ADMISSION THAT PREAMBLE IS PRIOR ART

The preamble elements in a Jepson-type claim (i.e., a claim of the type discussed in 37 CFR 1.75(e); see MPEP § 608.01(m)(m)) "are impliedly admitted to be old in the art, ... but it is only an implied admission." In re Ehrreich, 590 F.2d 902, 909-910 200 USPQ 504, 510 (CCPA 1979) (emphasis in original) (citations omitted). See also Sjolund v. Musland, 847 F.2d 1573, 1577, 6 USPQ2d 2020, 2023 (Fed. Cir. 1988); Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985); and Reading & Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984). Claims must be read in light of the specification. Where the specification confirms that the subject matter of the preamble was invented by another before applicant's invention, the preamble is treated as prior art. However, certain art may be prior art to one inventive entity, but not to the public in general. In re Fout, 675 F.2d 297, 300-301, 213 USPQ 532, 535-36 (CCPA 1982). This is the case when applicant has made an improvement on his or her own prior invention. An applicant's own foundational

Attorney Docket No. P68-US

work should not, unless there is a statutory bar, be treated as prior art solely because knowledge of this work is admitted."

The undersigned submits that, the clause before "*the improvement in which*" of claim 84, which was interpreted as admitted prior art by the examiner, is the work of the undersigned. In the present situation, clearly applicant believes the subject matter of the independent claims is his own work – therefore, the allegedly admitted prior art is applicant's own work and should not be used in against his claimed invention.

From the above, it is submitted that because a) a Jepson claim format is not ever applied to dependent claims; b) the preamble of a Jepson claim is an implied admission (and therefore can be overcome), and c) the concept of "applicant's admitted prior art" is not applicable to applicant's own work, thus the rejection of applicant's claims based on a Jepson sounding dependent claim is inappropriate. In any event, in order to further the prosecution of the present application, claim 84 has been amended to make clear that no admission of any sort was intended. Reconsideration and withdrawal of examiner's rejection of independent claims 1 and 41 is respectfully requested. Dependent claims 2-40 and 42-167 are allowable since they depend from allowable base claims.

§102(b) Rejection based on Pister (US5,726,480)

The examiner rejected independent claim 122 under 35 U.S.C. 102(b) as being anticipated by Pister (US 5,726,480). The undersigned respectfully submit that this rejection was made in error because Pister does not disclose or suggest all features set forth in claim 122. For example, claim 122 expressly recites a combination of features including a step of doping the silicon layer during or after depositing the silicon layer, and a step of releasing the micromechanical structural layer by removing the silicon layer by etching with a vapor phase etchant that comprises an interhalogen or a noble gas halide. Neither of these two steps was disclosed or suggested by Pister. In contrast, Pister teaches the etching of polysilicon with the gas phase XeF_2 . Therefore, it is respectfully submitted that claim 122 is allowable over Pister, as well as claims 123-132 that are dependent from claim 122. Reconsideration and withdrawal of the rejection are respectfully requested.

§102(b) Rejection based on Park (US5,994,238)

In response to examiner's rejection of claim 133, claim 133 has been canceled in favor of

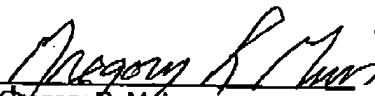
Attorney Docket No. P68-US

the prosecution of the remaining pending claims.

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. In the event any fees are required in connection with this paper, please charge our Deposit Account No. 501516.

Respectfully submitted,

REFLECTIVITY, INC.
350 Potrero Ave
Sunnyvale, CA 94085
Fax: (408) 737-8153


Gregory R. Mdir
Attorney for Applicant,
Registration No. 35,293
Tel: (408) 737-8100

Date: